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In re Application of: :
Jones et al. :
Serial No.: 10/541,657 : PETITION DECISION
Filed: March 3, 2006 :
Attorney Docket No.: 34.US5.PCT :

This is in response to the petition under 37 CFR § 1.181, filed February 17, 2010, requesting that the finality of the Office action of December 17, 2009 be withdrawn.

BACKGROUND

The examiner mailed a non-final Office action on March 9, 2009 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 1-85, 87-92 and 100 were pending. The examiner rejected claims 1-3, 9, 11-61, 70, 72-76 and 78 under 35 USC 112, first paragraph, as non-enabling. Claims 1-3, 9, 11-61, 70, 72-76 and 78 were rejected under 35 USC 112, second paragraph, as indefinite. Claims 1-3, 9, 12, 14-17, 32, 39, 41, 42 and 70 were rejected under 35 USC 102 (b) as being anticipated by Cocco et al. Claims 4-8, 10, 62-69, 71, 77, 79-8, 87-92 and 100 were withdrawn from consideration.

In reply to the non-final Office action of March 9, 2009, applicants filed a response on June 9, 2009. The response submitted by applicants included remarks, arguments traversing the rejections made in the non-final Office action and amendments to the claims.

On September 3, 2009, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 1-5, 12-14, 16-66, 73, 74, 78-85, 87-92 and 100 were pending. Claims 1-3, 12-14, 16-61, 73, 74 and 78 remained rejected under 35 USC 112, first paragraph, as non-enabling. Claims 1-3, 9, 11-61, 70, 72-76 and 78 remained rejected under 35 USC 112, second paragraph, as indefinite. Claims 1-3, 12, 16 and 78 were rejected under 35 USC 102 (e) as being anticipated by Griffith et al. Claims 4, 5, 62-66, 79-85, 87-92 and 100 were withdrawn from consideration.

The final Office action of September 3, 2009 was vacated due to a petition and petition decision regarding an earlier restriction requirement.

On December 17, 2009, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 1-5, 12-14, 16-66, 73, 74, 78-85, 87-92 and 100 were pending. Claims 1-3, 12-14, 16-61, 73, 74 and 78 remained rejected under 35 USC 112, first paragraph, as non-enabling. Claims 1-3, 12-14, 16-61, 73, 74 and 78 remained rejected under 35 USC 112, second paragraph, as indefinite. Claims 1-3, 12, 16 and 78 were rejected under 35 USC 102 (b) as being anticipated by Griffith et al. Claims 4, 5, 62-66, 79-85, 87-92 and 100 were withdrawn from consideration.

In response thereto, applicants filed this petition on February 17, 2010, requesting that the finality of the Office action of December 17, 2009 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed by applicants on February 17, 2010, applicants request that the finality of the Office action of December 17, 2009 be withdrawn as improper. Specifically, applicants argue that "The Office Action dated December 17, 2009 instead of merely withdrawing the rejection insofar as alleged that "heterocycloalkyl" was indefinite, substituted a new ground of rejection, by alleging that the claims were indefinite because the term "heterocyclic" used in the claims is unclear. Applicants have been provided with no opportunity to respond to this new ground of rejection. If Applicants had been presented with this ground of rejection originally, Applicants could have responded, for example, by pointing to the clear definition on p. 16 of the specification, amending the claims to further clarify them, or submitting a declaration or other evidence showing that the meaning of term would be apparent and clear to the person skilled in the art. Since the Office Action was made final, Applicants would be denied the opportunity to respond fully as of right, and Applicants have therefore been denied a full and fair hearing and the opportunity to fully develop this issue for appeal."

Applicants further point out "This is a new ground of rejection because the Examiner is making a new rejection over the term "heterocyclic" which was not part of the rejection in the previous office action. The Examiner contends that he made a mistake by previously reciting "heterocycloalkyl" instead of "heterocyclic", but these terms are different and Applicants would have no reason to know or even guess that the Examiner meant "heterocyclic" when he wrote "heterocycloalkyl." Thus, the Examiner's "correction" in the final office Action was a new ground of rejection. Applicants therefore respectfully submit that the Office Action dated December 17, 2009 was improperly made final, and that the finality of the Office Action should be withdrawn."

Applicants' argument is well taken and persuasive since applicants' amendments did not necessitate the new rejection. MPEP § 706.07 recites:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Thus, it is *not* proper for an office action to be made final when the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Accordingly, it is decided that Applicants' argument is well-taken and found persuasive.

DECISION

The petition is **GRANTED**.

The Office action mailed December 17, 2009 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action. Applicants' comments with regard to the Office action of March 9, 2009 are not considered relevant as the Office action of December 17, 2009 is now considered to be the non-final action due a response by applicants.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



George Elliott
Director, Technology Center 1600.